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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/388,723	09/02/1999	JAY S. WALKER	WD2-99-011	4361

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WALKER DIGITAL  
FIVE HIGH RIDGE PARK  
STAMFORD, CT 06905

EXAMINER

FADOK, MARK A

ART UNIT	PAPER NUMBER
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3625

DATE MAILED: 04/21/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/388,723

Applicant(s)

WALKER ET AL.

Examiner

Mark Fadok

Art Unit

3625

mw

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 26 January 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-29,31-43,45-104,107 and 109 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-29,31-43,45-104,107 and 109 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 02 September 1999 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

**DETAILED ACTION**

***Response to Amendment***

The examiner is in receipt of applicant's response to office action mailed 10/22/2003, which was received 1/26/2004. Acknowledgement is made that no amendments were included from the previously provided claims leaving claims 1-29,31-43,45-104,107 and 109 as pending. The terminal disclaimer for double patenting to patent US 6,249,772 has been received and that rejection has been removed, however, no disclaimer was received for double patent rejections to the co-pending applications, therefore, this rejection remains and is restated below. The applicant's arguments have been carefully considered, but were found not to be persuasive, therefore, the previous rejection is restated and modified as required to address applicant's request for additional art in support of Official Notice where deemed appropriate. (see response to arguments).

**Examiner's Note**

Examiner has cited particular columns and line numbers or figures in the references as applied to the claims below for the convenience of the applicant. Although the specified citations are representative of the teachings in the art and are applied to the specific limitations within the individual claim, other passages and figures may apply as well. It is respectfully requested from the applicant, in preparing the responses, to fully consider the references in entirety as potentially teaching all or part

of the claimed invention, as well as the context of the passage as taught by the prior art or disclosed by the examiner.

### ***Double Patenting***

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Please note that a Terminal Disclaimer may not be held in abeyance, therefore should the Applicant respond without a Terminal Disclaimer in their next response it will be considered nonresponsive.

**Claims 1-29,31-43,45-104,107 and 109 are provisionally rejected under the judicially created doctrine of double patenting over the claims and specification of copending Applications No. 09/337,906, 09/605,818 and 09/540,709. This is a provisional double patenting rejection since the conflicting claims have not yet been patented.**

The subject matter claimed in the instant application is fully disclosed in the referenced copending application and would be covered by any patent granted on that co-pending application since the referenced co-pending application and the instant application are claiming common subject matter, as follows: Both disclose a method for

purchasing a product online and passing on information to facilitate a redemption for the purchase at a retailer. The applications also claim features such as transferring said information to a voucher, offering rebates, and providing for the option to provide a substitute.

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

**Claims 1-29,31-43,45-104,106,107, and 109 are rejected under 35 U.S.C. 103(a) as being unpatentable over Garfinkle (6,512,570), in view of Woolston (6,266,651) in view of Bernard (5,918,213) and further in view of Official Notice.**

In regards to claims 1-29,31-43,45-104,106,107, and 109 Garfinkle discloses all the features of the instant claims except as follows:

Garfinkle teaches developing a contract between a retailer and a central controller which establishes costs (col 2, lines 1-65), but does not specifically mention

that the amount paid to the retailer is different or not based on a second price of the product that a buyer agreed to pay to a party different from the buyer. Woolston teaches consignment terms where an owner of merchandize negotiates terms of payment from the system in exchange for the system selling the product in an auction format (col 4, lines 20-50). The system of Woolston further does not explicitly teach that the payment to the retailer is not based on a first price agreed to between the buyer and purchasing system. Note, Woolston does not limit the terms and conditions, which can be agreed upon between an owner and the system.

The system of Garfinkle and Woolston teach negotiating a price between a buyer and a seller and having a buyer redeem the product and the retailer being reimbursed. The combination, however, does not specifically teach that the payment is based not on a price of the product that the buyer agreed to pay. Bernard teaches a vendor independent from the purchasing system contracting with the purchasing system (e.g. first price, col 24, lines 10-40), transferring of the order from the purchasing system to the external vendor (col 27, lines 20-25), an authorization system for the redemption of product (col 23, lines 45-65), means for redemption at a retailer different from the purchasing system (col 58, line 65 – col 59, line 67) and an agreed upon contract price between the external vendor and the purchasing system which is not based on a second price agreed to between the buyer and the purchasing system (col 51, line 20-col 53, line 50). It would have been obvious to a person having ordinary skill in the art to include the combination of Garfinkle and Woolston with the payment and pricing system as taught by Bernard, because the system of Bernard offers the functionality to market

product more effectively (col 31, lines 35-50) and also offers small retail outlets the ability to compete effectively with larger entities by having the centralized photo comparison capabilities and internet sales provided by a central location that is capable of mass marketing, thus increasing the usability and usage of the combined systems (Bernard col 55, lines 15-20).

Garfinkle teaches purchasing a product online and later picking it up at a designated retailer. But does not specifically teach all of the redemption methods of the instant claims. It is old and well known in the art to provide redemption information in the form of a voucher, where the buyer presents this information in return for a product or service. It would be obvious to a person of ordinary skill in the art to include in Garfinkle the redemption methods of the instant claims, because this would provide an alternate means to completing the transaction, which may be more favorable to a buyer and cause the buyer to use the system more frequently thus increasing sales.

### ***Response to Arguments***

Applicant's arguments filed 1/26/2004 have been fully considered but they are not persuasive.

Applicant argues the use of Official Notice in reference to the feature "wherein the payment is based on a second price of the product agreed upon between a retailer and the purchasing system *and is not based on a second price of the product that the buyer agreed to pay to the party* different from the buyer", more particularly that which is

italicized. In response to this request the examiner offers the reference Bernard. Bernard teaches a vendor independent from the purchasing system contracting with the purchasing system (e.g. first price, col 24, lines 10-40), transferring of the order from the purchasing system to the external vendor (col 27, lines 20-25), an authorization system for the redemption of product (col 23, lines 45-65), means for redemption at a retailer different from the purchasing system (col 58, line 65 – col 59, line 67) and agreed upon contract price between the external vendor and the purchasing system is not based on a second price agreed to between the buyer and the purchasing system (col 51, line 20-col 53, line 50).

Applicant argues the use of Official Notice to address the plethora of claims related to various aspects of redemption in the dependant claims. A “traverse” is a denial of an opposing party’s allegations of fact. The Examiner respectfully submits that applicants’ arguments and comments do not appear to traverse what Examiner regards as knowledge that would have been generally available to one of ordinary skill in the art at the time the invention was made. Even if one were to interpret applicants’ arguments and comments as constituting a traverse, applicants’ arguments and comments do not appear to constitute an adequate traverse because applicant has not specifically pointed out the supposed errors in the examiner's action, which would include stating why the noticed fact is not considered to be common knowledge or well-known in the art. 27 CFR 1.104(d)(2), MPEP 707.07(a). An adequate traverse must contain adequate information or argument to create on its face a reasonable doubt



regarding the circumstances justifying Examiner's notice of what is well known to one of ordinary skill in the art. In re Boon, 439 F.2d 724, 728, 169 USPQ 231, 234 (CCPA1971).

If applicant does not seasonably traverse the well known statement during examination, then the object of the well known statement is taken to be admitted prior art. In re Chevenard, 139 F.2d 71, 60 USPQ 239 (CCPA 1943).

Further applicant argues that "it is never appropriate to rely solely on 'common knowledge' in the art without evidentiary support in the record, as the principle evidence upon which a rejection was based and cited Zurko. The examiner would like to direct the applicants attention to the previous rejection dated April 30<sup>th</sup> 2003, which addressed each claim limitation, this is considered evidentiary support for the old and well known statement. In addition the rejection is not solely based on Official Notice, but is anchored in the cited art of Garfinkle and Woolston.

In response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, both of the

references are in the same field of electronic commerce and as such both dealing with the sale of goods over the Internet.

### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to **Mark Fadok** whose telephone number is **(703) 605-4252**. The examiner can normally be reached Monday thru Thursday 8:00 AM to 5:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, **Vincent Millin** can be reached on **(703) 308-1065**.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the **Receptionist** whose telephone number is **(703) 308-1113**.

Any response to this action should be mailed to:

***Commissioner for Patents***

***P.O. Box 1450***

**Alexandria, Va. 22313-1450**

or faxed to:

**(703) 872-9306** [Official communications; including  
After Final communications labeled  
"Box AF"]

**(703) 746-7206** [Informal/Draft communications, labeled

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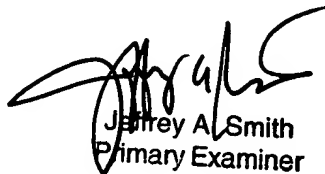
"PROPOSED" or "DRAFT"]

Hand delivered responses should be brought to Crystal Park 5, 2451 Crystal Drive, Arlington, VA, 7<sup>th</sup> floor receptionist.



Mark Fadok

Patent Examiner



Jeffrey A. Smith  
Primary Examiner